REMARKS

Reconsideration and allowance of the above-referenced application are respectfully requested.

The indication that Claims 7 and 13 have been allowed is appreciatively noted. The indication that Claims 2-4, 8 9, 11 and 12 would be allowable if rewritten to include the limitations of any claims on which they depend is appreciatively noted.

Claims 1 and 10 stand rejected under 35 USC 102(e)over U.S. Patent Publication No. 2003/0155595 to Okita ("Okita"). This contention is respectfully traversed.

Claim 1 has been amended to clarify that the ferroelectric material is deposited *on* an insulating layer. Okita's figure 3D shows the ferroelectric film 14 on the conductive film 13. The ferroelectric material in Okita is not *on* an insulating layer, as it is instead *on* a conductive film.

Claim 1 requires depositing an electrode layer into the openings formed in the ferroelectric layer. In Okita Figure 3F shows a capacitor protective film 18 deposited on a insulating film 8. The Examiner refers to U.S. Patent Publication No. 2001/0055869 to Marsh ("Marsh") (and indirectly U.S. Patent Publication No. 2002/0154265 to Hubby ("Hubby")) as disclosing alumina as an electrode layer. This contention is respectfully traversed.

Okita specifically requires a "protective film 18, made of alumina". In the context of this technology this clearly is not an electrode layer, since it could reasonably be assumed a "protective film" is protective in a chemical and electrical sense i.e. resists etching and is electrically insulating. Okita clearly teaches "lower electrodes 13a 13b" as iridium (Ir), platinum oxide (PtO) and "upper electrodes 15a 15 b" as iridium oxide (IrO_2).

Applicant submits that a skilled reader could not possibly interpret the protective layer 18 as an electrode layer, since in Q1, for example, the protective layer 18 would short circuit the upper electrode 13a, the ferroelectric film 14a and upper electrode 15a. Clearly Q1 in Okita could not function as a capacitor if this were to be the case. This is a consequence of Okita disclosing a horizontal capacitor, not a vertical capacitor as required by claim 1. If charged with designing a vertical capacitor, a skilled reader is unlikely to refer to teachings regarding horizontal capacitors, without the benefit of hindsight.

Even if the protective film were considered an electrode layer (which is most strenuously not admitted) alumina is not an electrode material. We attach as exhibit "A" a page from the website Wikipedia, which clearly refers to alumina as being an

insulator. Further evidence of the insulating properties of alumina can be supplied if required.

The rejection has combined the disclosures of Okita and Marsh under 35 USC 102(e). This is legally improper - see MPEP section 2131.01 (II). The term to be construed in this case is "protective film". Therefore the suggested combination of Okita and Marsh is improper under 35 USC 102(e), and in any event does not disclose depositing an electrode layer into the openings formed in the ferroelectric layer.

Okita does not disclose the required features of Claim 1. Applicant submits Claim 1 is patentable over Okita in isolation or over Okita in combination with Marsh (even though it is not admitted such a combination is valid).

It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any

claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Applicants asks that all claims be allowed. Please apply the additional claim fee in the amount of $500, and any other applicable charges or credits, to Deposit Account No. 06-1050.

Respectfully submitted,

Date: November 22, 2006

Scott C. Harris
Reg. No. 32,030

Fish & Richardson P.C.
PTO Customer No. 20985
12390 El Camino Real
San Diego, California 92130
(858) 678-5070 telephone
(858) 678-5099 facsimile

10686021.doc